

## **REMARKS**

### **Amendments**

Claims 1-3 and 5-7 are cancelled. Claim 4 is amended to recite that  $R^3$  is phenpropyl,  $-C(O)R^4$ ,  $-(CH_2)_n C(O)R^4$ ,  $-(CH_2)_n OR^5$ ,  $-(CH_2)_n SR^5$ ,  $-(CH_2)_n SO_2R^4$ ,  $-(CH_2)_n NR^5R^6$ ,  $-CH_2CO_2R^5$ ,  $-CH_2CONR^6R^5$ ,  $-(CH_2)_n NR^6SO_2R^4$ ,  $-(CH_2)_n NR^6COR^4$ , or  $-CH_2CONHSO_2R^4$ . It is noted that  $-CH_2CONHR^5$  is not included in this list as it is redundant with  $-CH_2CONR^6R^5$  when  $R^6$  is H. Claim 4 is also amended to recite the proviso that when  $R^3$  is  $-CH_2CONR^6R^5$ ,  $R^5$  is benzyl, thiazolyl, benzoxazolyl, benzthiazolyl, benzimidazolyl, benzothiazolyl, tetrahydroisoquinolyl, thiadiazolyl, indolyl, indanyl, benzodioxanyl,  $-CH_2$ -benzothiazolyl, or  $-CH_2$ -pyridinyl, which in each case is substituted or unsubstituted. See, for example, the specific compounds described in applicants' specification. These amendments further distinguish the claims from Serial No. 11/253,812 and US 7,235,579.

Claims 8, 9, 32 and 33 are amended to be consistent with claim 4. Claims 17 and 25 are amended to correct obvious typographical errors.

New claim 37 is directed to compounds deleted from claim 8. New claim 38 is directed to certain compounds of claim 37. New claim 39 directed to compounds deleted from claim 9. New claim 40 is directed to certain compounds of claim 39. Claims 41-44 are directed to pharmaceutically compositions containing compounds from claims 37-40, respectively. New claim 45 and 46 are directed to certain compounds of claim 8 and claim 9, respectively.

### **Related Application**

The applicants wish to bring to the Examiner's attention that the instant application was applied in an obviousness-type double patenting rejection in application Serial No. 11/253,812. US 7,235,579 was also applied in an obviousness-type double patenting rejection in application Serial No. 11/253,812.

### **Withdrawn Subject Matter**

In the Office Action of May 20, 2007, it is asserted applicant did not point out errors in the Restriction Requirement, and that the "election" was being treated as an election without traverse. It is correct that Applicants did not traverse the prior **Restriction Requirement**, but instead applicants indicated they would request rejoinder pursuant to MPEP §821.04 with regards to the non-elected method claims.

However, the present Office Action now appears to attempt to convert the prior Election of Species Requirement into a Restriction Requirement. This is improper and applicants strongly traverse this action.

With respect to the prior Election of Species Requirement, applicant hereby elect 4-[4-Methoxy-3-tetrahydrofuranloxyphenyl]-1-[N-(5-(4-methoxyphenyl)-1,3,4-thiadiazol-2-yl)aminocarbonyl-methyl]-2-pyrrolidone. As applicants' claims are Markush claims, following the election of a species, examination should proceed in accordance with MPEP 803.02. The claims are to be examined with respect to the elected species, and, if the elected species is found to be allowable over the prior art, the search is to be extended to the extent necessary to determine patentability of the Markush claim..

The Examiner's failure to extend the search and conversion of the Election of Species Requirement into a Restriction Requirement amount to imposing a Restriction within a single claim. Applicants respectfully submit that 35 USC §121 does **not** permit restriction within a single claim (except in one specific circumstance described below) as clearly indicated by the court in *In re Weber et al.*, 198 USPQ 328 (1978).

As a general proposition, an applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits.

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It is apparent that §121 provides the Commissioner with the authority to promulgate rules designed to *restrict* an *application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to *reject* a particular claim on that same basis. [*Weber* at 331-332]

The effect of restriction within a single claim is the same as a rejection. 35 USC §121 does not give the Commissioner authority to require that a single claim "be divided up and presented in several applications" and thus deny the Applicant the right to have that single claim considered on its merits. This is exactly the action that the Court in *Weber* stated was not permitted under 35 USC §121. Such action by an Examiner would violate "the basic right of the Applicant to claim his invention as he chooses." [*Weber* at 332]

The claims here are Markush claims. As stated in MPEP §803.02, "[s]ince the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is **improper** for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention." (emphasis added) Thereafter, the MPEP cites *In re Harnish*, 206 USPQ 300 (CCPA 1980) and *Ex parte Hozumi*, 3 USPQ2d (Bd. Pat. App. & Int. 1984).

These two cases, *Harnish* and *Hozumi*, both deal with improper Markush rejections. Thus, in the case of Markush claims, refusal by the Office to examine that which the applicants regard as their invention, by restricting within a Markush claim, must be a refusal based on an improper Markush rejection. In both *Harnish* and *Hozumi*, the Court and the Board, respectively, decided that the Markush groups in question were **not improper**, and therefore restriction within a claim was not permitted. In other words, in the case of a **proper** Markush grouping, restriction within a claim is **not** permitted.

In the instant case, no improper Markush rejection has been made. Nor has the Examiner demonstrated that the subject matter of the Markush group lacks unity of invention based on the criteria set forth in *Harnisch*, i.e., the compounds (1) do not share a common utility, or (2) do not share a substantial structural feature.

In view of the above remarks, examination should proceed in accordance with MPEP §803.02.

**Claim Objections**

At page 4 of the Office Action it is stated that claims 1-11 and 28-36 are objected to for depending on a rejected base claim. This is apparently a typographical error since no claims are under rejection. Presumably, the Examiner intended to object to the claims for containing non-elected subject matter. However, this objection is traversed for the reasons stated above.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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